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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,366	01/28/2004	Pauline Pan	A0000367-03-EJF	2888
7590 Darryl C. Little, Esq. Pfizer Inc. 201 Tabor Road Morris Plains, NJ 07950			EXAMINER ROBERTS, LEZAH	
			ART UNIT 1614	PAPER NUMBER
			MAIL DATE 10/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,366

Applicant(s)

PAN ET AL.

Examiner

Lezah W. Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-19 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) 28-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-19, 21-27 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This Office Action is in response to the Request for Continued Examination filed July 25, 2007. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Status: Claim 33 is classified as a new claim but was previously submitted in the Amendment filed October 30, 2006. It will be treated as a previously submitted claim.

Claims

Claim Rejections - 35 USC § 103 – Obviousness

1) Claims 1, 6-7, 17, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyahara et al. (US 4,693,888). The rejection is maintained.

Applicant's Arguments

Applicants argue the compositions of the present invention specifically require combining hinokitiol with an oral care effective amount of at least one essential oil in an oral carrier comprising about 20% to 30% by weight of ethanol. Nowhere does Miyahara teach the oral care benefits of hinokitiol apart from its claimed antigen-synergist combination, much less any benefits of hinokitiol by incorporating it with the specific elements of the present invention. These arguments are not persuasive.

Examiner's Response

The claims do not recite a specific function for hinokitiol other than it is in an effective amount. Absent of unexpected results, it would be obvious to add hinokitiol to

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the oral compositions of the reference comprising a flavoring, which is an essential oil, because the reference suggests using hinokitiol in the disclosed compositions.

2) Claims 1, 3-19, 21-27 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fand et al. (US 3,164,524) in view of Iyer et al. (US 5,939,050). The rejection is maintained.

Applicant's Arguments

Applicant argues nowhere does Iyer et al. teach the oral care benefits of hinokitiol apart from the cited antimicrobial agents, much less improving any benefits of hinokitiol by incorporating it with the specifically claimed element of the present invention. Since Iyer nowhere teaches or suggests the oral care benefits of hinokitiol in and of itself, the composition of the present invention would not have been obvious over this reference. Combining Fand or Talwar with Iyer does not cure the inadequacy of Iyer. Neither Fand or Talwar mention hinokitol, much less teaches its usefulness in oral care. Since none of the three references teaches the oral care benefits of hinokitiol, the compositions of the present invention would not have been obvious over these references in combination. These arguments are not persuasive.

Examiner's Response

Fand and Talwar are the primary references in the corresponding rejections. Iyer is used to disclose components that are suitable ethanol comprising compositions. Iyer also discloses hinokitiol has antimicrobial effects, which is its oral care benefit. Therefore it would have been obvious to one of ordinary skill in the art to have

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incorporated the hinokitiol into the compositions of the primary references motivated by the desire to incorporate the hinokitiol for its antimicrobial effect. Furthermore the claims do not recite the oral care benefit of the hinokitiol, only that it is comprised in an oral care composition comprising another essential oil and ethanol.

3) Claims 1-19, 21-27 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talwar et al. (US 4,945,087) in view of Iyer et al. (US 5,939,050).

See Applicant's arguments and Examiner's response above in subsection 2.

Claims 1-19, 21-27 and 31-33 are rejected.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lezah Roberts
Patent Examiner
Art Unit 1614



Frederick Krass
Primary Examiner
Art Unit 1614

